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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,087	10/19/2001	Leonard Arnold Duffy		9503

7590 04/04/2006
Leonard Duffy
P O Box 99
Hinesburg, VT 05461

EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,087	DUFFY, LEONARD ARNOLD	
	Examiner	Art Unit	
	James R. Brittain	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18-23, 25-34 and 44-59 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7, 9-11, 14-16, 18-23, 25-32, 48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 12, 13, 33, 34, 44-47 and 50-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Claims 48 and 49 are withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6. The apparatus was restricted out.

Additionally, claims 3-5, 7, 9-11, 14-16, 18-23 and 25-32 are withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected species or device for making the fastener in the case of claims 52-59 without traverse, there being no allowable generic or linking claim. Upon allowance of a generic claim and if all article claims are amended to include the subject matter of the generic claim, then all species readable on the generic claim will be rejoined.

Claims 48 and 49 are withdrawn for the reason cited in the Office action mailed September 9, 2004 and also are withdrawn because of the unclear nature of the claimed invention and their apparent tie to the method of making the device that was subject to the prior restriction requirement. While claim 48 identifies the invention as “A method of fastening two portions ...” with several steps utilizing the term “providing”, it is only in claim 49 that the full extent of applicant’s use of the term “providing” is exposed, wherein the apparatus consisting of interengaging dies is explicitly claimed and places these claims outside the article claims elected by applicant.

Applicant queries in the communication of October 8, 2004 the conditions under which the method of making claims would be rejoined. Method of making claims would be rejoined if

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all process of making claims include all of the limitations of the allowed article claim and are allowable on the basis of 35 U.S.C. 112.

Claims 50-59 are all rejoined and rejected as indicated below.

Specification Objections

Applicant has indicated a desire to delete figures 6 and 6a. This is accepted. However, the specification requires revision to renumber all references to the figures numbered greater than 6 by reducing the number by one so that there is no gap in figure numbering. Correction is required.

Drawing Objections

The drawings are objected to because applicant proposed to eliminate figures 6 and 6a while not renumbering the figures by reducing all figures numbered greater than 6 by reducing the number by one so that there is no gap in the figure numbering. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-59 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are drawn to the fastening device. There is no criteria to determine how the apparatus used to make the device, which comprises the subject matter of these claims, could be determined from inspection of the finished fastener product. This renders the claims indefinite.

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Further, it is unclear if the final product in identical form to that claimed, but made by different apparatus would fall within the scope of these claims. The final product structure must unequivocally fall either within the scope of the claims or outside of the scope of the claims and not render a different result depending upon the apparatus utilized to make it.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 12, 13, 33, 34, 44, 45, 47 and 50-59 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duffy (US 5983467) in view of Allan (US 5640744).

Duffy (figures 1-8) teaches a slidably engageable fastening device operable upon application of a relative shearing force, comprising: a first portion that includes: a first base having a first basal surface; and a plurality of first undercut segments spaced from the first basal surface; and a second portion for slidably engaging with the first portion upon application of a relative shearing force with respect to the first and second portions, the second portion including: a second base having a second basal surface; a plurality of stems each having a first end attached to the second base and a second end distal from the second basal surface; and at least one second undercut segment attached to each of the plurality of stems at the second end and extending away from the each stem, thereby providing an aperture for receiving adjacent pairs of the first undercut segments between adjacent pairs of the stems. The difference is that the base lacks fenestrations. It would have been obvious to modify the base of the device of Duffy so as to

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have fenestrations in view of Allan (figure 21) teaching that it is desirable to place fenestrations 141 in the base for ease of attaching to an object by sewing, a common expedient. Applicant is familiar with the teachings of his prior patent and is fully aware of the sliding engagement taught by therein. The placement of apertures in the base is a common expedient for attachment such as that evidenced by Allan and one having ordinary skill in the art would readily recognize the use of apertures for attachment and applicant's patent shows the use of sewing to attach the base to an object. The bilateral disposition of stems is taught in applicant's prior patent. As to claim 45, the combination with Allan suggests using the fastener on different sections or portions of footwear. As to claims 50-59, so far as definite, there is nothing in these claims impacting the structure of the final product in a manner that is unequivocal. The combined teachings of Duffy and Allan create a structure that could be made by the apparatus listed in these claims.

Claim 46 is rejected under 35 U.S.C. §103(a) as being unpatentable over Duffy (US 5983467) in view of Allan (US 5640744) as applied to claim 45 above, and further in view of Sink (US 5943705).

Further modification of the fastener of Duffy as modified by Allan such that the interengaging portions are on a strap spaced by an elastic section would have been obvious in view of Sink (figures 3, 4 as described in the abstract) teaching the use of two non-elastic portions positioned at either end of an elastic portion with the two non-elastic portions including hook and loop fasteners for fastening the two non-elastic portions to each other so as to have a readily adjustable strap.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that providing fenestrations to the substrate provides enhanced flexibility, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, Allan suggests fenestrations in the substrate that would inherently provide enhanced flexibility.

Reference can be combined for reasons other than applicant's reason and the references the above rejection provides a reason for combining the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB